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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/691,753

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Scot Cuthbertson

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2421

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/691,753	Applicant(s) CUTHBERTSON, SCOT	
	Examiner Hoang-Vu A. Nguyen-Ba	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/20/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2008 has been entered.
2. Claims 1 and 3-12 are now pending. Claim 1 is an independent claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-9 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 1176 821 A1 by Victor Fielding ("Fielding") in view of Japanese Publication No. 09-288526 by Fukutani Junichi ("Junichi") (Junichi reference being listed in Applicant's 1449 filed with above-mentioned RCE).

Claim 1

Fielding discloses at least *a digital television converter (see at least FIG. 1) for a television apparatus, said television apparatus which is incapable of reception of digital television broadcasts, said converter comprising:*

a connector for mating with a corresponding connector on said television apparatus so as to make electrical contact therewith and be mechanically supported thereby (see at least FIG. 1, items 10, 12); and

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a SCART connector rear housing which cooperates with said connector to form a compact enclosure containing and mechanically supporting said tuner (see at least FIG. 1, items 4, 6). Fielding does not specifically disclose the remaining features of the claim.

However, in an analogous art, Junichi discloses:

a tuner for selecting and demodulating a digital television channel and for supplying to said connector signals in a form suitable for use by said apparatus (see at least FIG. 1, device 7);

wherein a height of said housing is approximately less than twice that of the SCART connector in order to provide a relatively compact converter (see at least FIGs. 1-3, the height of the housing of the tuner being 7a is obviously less than twice that of the tuner because 7a is only half of twice the height of the tuner, i.e., $2 \times 7a$); and

a power supply input connector mounted on said enclosure for connection to a remote power supply (see at least FIG. 4, input 14).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Fielding, as suggested in [0030], to accept the assembly of Junichi because this modification would allow a user with an analog television to watch digital broadcasting without having to purchasing a new digital television, a new STB and all necessary connectors and wiring for the new setup.

Claim 3

The rejection of base claim 1 is incorporated. The combination Fielding-Junichi further discloses *said tuner has an input, said connector comprising an aerial input connector fixed to said housing and electrically connected to said input of said tuner (Junichi; see at least FIG. 1, connector 6 of device 5).*

Claim 4

The rejection of base claim 1 is incorporated. The combination Fielding-Junichi further discloses a converter as claimed in claim 1, comprising *a printed circuit board, said tuner being mounted on said printed circuit board which is electrically connected to said connector and*

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which is mechanically connected to said connector so as to be supported thereby (Junichi; see at least FIG. 5, printed circuit board 18).

Claim 5

The rejections of base claim 1 and intervening claim 4 are incorporated. The combination Fielding-Junichi further discloses *said connector comprises a plurality of terminals with rear portions connected to said circuit board* (see at least Fielding, Fig. 1, items 6, 4).

Claim 6

The rejections of base claim 1 and intervening claims 4, 5 are incorporated. The combination Fielding-Junichi further discloses *said circuit board extends below said rear portions* (Junichi; see at least FIG. 5, when connected, printed circuit board is lower than the plane of device 5).

Claim 7

The rejections of base claim 1 and intervening claims 4, 5 are incorporated. The combination Fielding-Junichi further discloses *said rear portions extend rearwardly and then downwardly so as to connect to said circuit board* (see at least Fielding, Fig. 1, items 4, 6).

Claim 8

The rejections of base claim 1 and intervening claim 4 are incorporated. The combination Fielding-Junichi further discloses *said connector comprises a body to which said circuit board is mechanically fixed* (Junichi; see at least, FIG. 1, device 5).

Claim 9

The rejection of base claim 1 is incorporated. The combination Fielding-Junichi further discloses *a further connector mounted on said enclosure for mating with a further mating cable-end connector* (Junichi; FIG. 1, device 5).

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Claim 11

The rejection of base claim 1 is incorporated. The combination Fielding-Junichi does not specifically disclose *said tuner includes a controller for controlling said converter in response to remote control signals*.

However, since Junichi teachings of circuit design are based on a modular approach (e.g., different modules – tuner or camera -- installed on the same printed circuit board), it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate an infrared remote controller receiver module into the circuit board of Junichi, this IR remote receiver being connected to the digital tuner through the available bus on the printed circuit board because this would enable a user to be able to control remotely the functions of the tuner, thereby making the combined device more autonomous without the use of additional discrete components.

Claim 12

The rejections of base claim 1 and intervening claim 11 are incorporated. The combination Fielding-Junichi does not specifically disclose *a remote control signal input receiver mounted on said enclosure*.

However, as discussed in Claim 11, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a remote control signal input receiver mounted on the combined circuit of Fielding-Junichi because this would enable a user to be able to control remotely the functions of the tuner, thereby making the combined device more autonomous without the use of additional discrete components.

5. Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over EP 1 176 821 A1 by Victor Fielding ("Fielding") in view of Japanese Publication No. 09-288526 by Fukutani Junichi ("Junichi") and further in view of EP 1 045 584 A2 by Mark Smith ("Smith").

Claim 10

The rejections of base claim 1 and intervening claim 9 are incorporated. The

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combination Fielding-Junichi does not specifically disclose *a changeover switching arrangement for selectively connecting said connector to one of said tuner and said further connector*.

However, Smith teaches a power loopthrough arrangement that allows video/audio signals to be transferred from the VCR to the television via the satellite receiver even when the satellite receiver is off for the purpose of allowing cost savings in electricity.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the loopthrough arrangement in the combination Fielding-Junichi because this would allow cost savings in electricity and in hardware.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hoang-Vu A. Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Monday -Friday from 9:00 – 17:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist: 571-272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/

Primary Examiner, Art Unit 2421

January 12, 2009

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